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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85706113
Applicant	United Trademark Holdings, Inc.
Applied for Mark	ZOMBIE CINDERELLA
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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. 85/706,113

Mark: ZOMBIE CINDERELLA

Applicant: United Trademark Holdings, Inc.

Examining Attorney: David A. Hoffman
Law Office 107

APPLICANT'S *EX PARTE* APPEAL BRIEF

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COMES NOW Applicant, United Trademark Holdings, Inc., by Counsel, and hereby respectfully appeals the Examining Attorney's refusal to register Applicant's standard character ZOMBIE CINDERELLA mark in Application Serial No. 85/706,113 ("the Application"). The Examining Attorney has refused registration pursuant to Trademark Act 2(d), 15 U.S.C. § 1052(d), on the grounds that Applicant's ZOMBIE CINDERELLA mark for use in connection with "dolls" in Class 28 is likely to be confused with the WALT DISNEY'S CINDERELLA &



Design mark in Reg. No. 3,057,988, for use in connection with "toys, namely plush toys, action figures, dolls, soft sculpture toys, stuffed toys" in Class 28. The refusal is inappropriate because the significant differences between the marks are sufficient to distinguish the sources of the goods offered in connection with each mark, the cited mark is entitled to a narrow scope of protection, and the term shared by the marks is weak and diluted.

PROSECUTION HISTORY

Applicant filed the Application on an intent-to-use basis on August 17, 2012, seeking registration on the Principal Register for the mark ZOMBIE CINDERELLA in standard characters for use in connection with "dolls" in Class 28.

Grounds for Refusal: Likelihood of Confusion

On December 21, 2012, the Examining Attorney issued a Non-Final Office Action (the "Office Action"), refusing registration under Trademark Act §2(d) on the ground that Applicant's mark is likely to be confused with the WALT DISNEY'S CINDERELLA & Design mark in Reg. No. 3,057,988.

On March 7, 2013, Applicant submitted a response ("OAR"), in which Applicant offered arguments and evidence against the refusal to register the mark under Trademark Act §2(d).

On April 25, 2013, the Examining Attorney issued a Final Office Action regarding the refusal under Trademark Act §2(d). The refusal on grounds that Applicant's mark was likely to be confused with the mark in Reg. No. 3,057,988 was made final.¹

On October 25, 2013, Applicant filed a Request for Reconsideration ("RFR"), in which Applicant offered additional arguments and evidence against the refusal on the grounds of likelihood of confusion with the mark in Reg. No. 3,057,988. Applicant also filed a Notice of Appeal with the Board on October 25, 2013. *See* Docket Doc. 1. The Board acknowledged and instituted the appeal and remanded it to the Examining Attorney for consideration of Applicant's RFR on the same day. *See* Docket Doc. 2.

On November 19, 2013, the Examining Attorney issued a Reconsideration Letter, in which the final refusal under Trademark Act §2(d) was continued and maintained. The Examining Attorney also attached additional evidence in support of the refusal. On November 20, 2013, the Board issued an order resuming the appeal and allowing Applicant 60 days to file its Appeal Brief. *See* Docket Doc. 11.

SUMMARY OF EVIDENCE

A. Examining Attorney's Evidence

Office Action of December 21, 2012:

- USPTO Record for Reg. No. 3,057,988

Final Office Action of April 25, 2013:

- USPTO Record for Reg. No. 3,057,988
- Google Image Search Results for "zombie dolls"
- Toys R Us Online Catalog Search Results for "zombie"

¹ The Final Office Action also references Reg. No. 2,895,966, but appears to do so in error as the mark in that registration is WALT DISNEY'S SLEEPING BEAUTY & Design.

- Amazon.com Search Results for “zombie plush toys”
- Think Geek Catalog Search Results for “zombie plush toys”
- TESS Entries for Reg. Nos. 3,729,029; 3,849,768; 3,903,014; 3,636,779; and 4,096,890
- Screenshot of Topless Robot’s list of “10 Incredibly Great Zombie Toys” and accompanying reader comments

Reconsideration Letter of November 19, 2013:

- Scientific American Blog Article on “Zombie Fever: A Mathematician Studies a Pop Culture Epidemic”
- Huffington Post Blog Article on “The Evolution of Zombies in Pop Culture”
- Esquire Blog Article on “Why Zombies are Everywhere Now”
- TESS Entry for Reg. No. 4,264,759
- Britannica Online Encyclopedia Excerpt on “Walt Disney”
- Britannica Online Encyclopedia Excerpt on “zombie”

B. Applicant’s Evidence



Office Action Response of March 7, 2013 (“OAR”):



Exhibit A: “Cinderella (1950 film),” *Wikipedia.org*,
[http://en.wikipedia.org/wiki/Cinderella_\(1950_film\)](http://en.wikipedia.org/wiki/Cinderella_(1950_film)) (accessed March 6, 2013).

Exhibit B: “Cinderella,” *Wikipedia.org*, <http://en.wikipedia.org/wiki/Cinderella> (accessed March 6, 2013).

Exhibit C: “Zombie,” *Merriam-Webster’s Dictionary*, <http://www.merriam-webster.com/dictionary/zombie> (accessed March 6, 2013).

Exhibit D: Third-Party Registration Certificates for the following registrations:

Mark	Reg. No.	Relevant Goods/Services
Cinderella	4270713	<u>Class 37</u> : Cleaning of buildings; Cleaning of commercial premises; Cleaning of industrial premises; Cleaning of residential houses; Maid services
	4209545	<u>Class 28</u> : Hunting game calls
CINDERELLA EYEBROWS SPA	3916845	<u>Class 44</u> : Body waxing services; Eyebrow threading services; Health spa services, namely, laser treatments for acne, rejuvenation, scars, tattoo removal and for facials and massage; <u>Massage therapy services</u>
CINDERELLA CLASSIC	3201575	<u>Class 41</u> : Conducting entertainment exhibitions in the nature of bicycle touring, bicycle equipment, bicycle manufacturers, women's clothing, and women's non-profit organizations; Entertainment namely, production of bicycle tours; Entertainment services, namely, participation in bicycle tours; Organizing exhibitions for bicycle touring, bicycle equipment, bicycle manufacturers, women's clothing, and women's non-profit organizations
	4000248	<u>Class 9</u> : Slot machines and replacement parts therefor; video slot machines and replacement parts therefor; gaming machines and replacement parts therefor; gaming machines with a liquid crystal display and replacement parts therefor; mechanical reel type slot machines with a liquid crystal display and replacement parts therefor; media storage computer software for electronic circuits, optical disks, magnetic tapes, magnetic disks, magnetic cards, optical-magnetic disks, CD-ROMs, ROM-cartridges and DVDs, namely, computer software for controlling slot machines and game machines; computer game software for game machines and slot machines
CINDERELLA'S SEA	3827570	<u>Class 9</u> : electrical switch plates.
Cinderella's Day Job	3668716	<u>Class 37</u> : Cleaning residential and commercial buildings.
Savvy Cinderella	3876007	<u>Class 35</u> : Providing an online marketplace bringing together buyers and sellers of new and gently used wedding items including, but not limited to, wedding dresses, jewelry, accessories, party favors, and reception and ceremony items

Mark	Reg. No.	Relevant Goods/Services
Cinderella Maid Service	3936315	Class 37: Cleaning of buildings; Cleaning of industrial premises; Cleaning of residential houses; Maid services
The Cinderella Procedure	3698389	Class 44: Medical services
CINDERELLA BALL	3384665	Class 36: Charitable fund raising services by means of an entertainment event
	3662574	Class 35: Association services, namely, promoting the interests of women
Cinderella Soap Company	3432137	Class 3: Bath salts; Bath soaps in liquid, solid or gel form; Body lotions; Body scrub; Hand lotions; Hand soaps; Non-medicated body soaks; Pet shampoo; Scented body spray; Scented linen sprays; Scented room sprays; Soaps for body care; Soaps for household use
	2947406	Class 5: feminine hygiene cleansing towelettes, feminine hygiene pads, sanitary napkins, sanitary pads, panty liners, panty shields
CINDERELLA	2838899	Class 35: Cooperative advertising and marketing services in the nature of promotion and facilitation of third parties' efforts toward economic and physical redevelopment and residential and commercial revitalization; and developing promotional campaigns to support construction and financing of commercial and residential redevelopment Class 36: Financial services in the nature of providing financing for such residential and commercial redevelopment and revitalization, including financing for the construction of low and middle income housing Class 37: Construction and repair services in the nature of renovation and rehabilitation of commercial and residential buildings and neighborhoods and the construction of low and middle income housing
CINDERELLA	1696364	Class 31: live crabapple trees


Mark	Reg. No.	Relevant Goods/Services
CINDERELLA	1963067	<u>Class 25</u> : footwear
CINDERELLA	1337251	<u>Class 41</u> : Entertainment Services in the Nature of a Musical Group
CINDERELLA	0746696	<u>Class 10</u> : Children's and Girls' Dresses, Rompers, Play Suits, Separate Slacks, Creepers
	0532543	<u>Class 25</u> : LADIES' SHOES

Exhibit E: Amendment and Request for Reconsideration of July 15, 2003, for Cited Registration No. 3,057,988.

Request for Reconsideration of October 25, 2013 (“RFR”):

Exhibit F: Charles Perrault, *Cinderella; or, the Little Glass Slipper* (University of Pittsburgh trans.), available at <http://www.pitt.edu/~dash/perrault06.html> (accessed Oct. 22, 2013).

Exhibit G: Excerpt from Linda S. Watts, *Entry for Cinderella*, The Encyclopedia of American Folklore 74 (2007), available at http://books.google.com/books?id=2dce6_CA76MC&pg=PA355&lpg=PA355&dq=sleeping+beauty+encyclopedia&source=bl&ots=FlARSMX0eh&sig=UJB1jwUcpSkPwV2RlmRFJkYlCJE&hl=en&sa=X&ei=G_lfUuCrO9So4AP8q4HICA&ved=0CFIQ6AEwBjgo#v=onepage&q=cinderella&f=false (accessed October 22, 2013).

Exhibit H: “Cinderella,” *Merriam-Webster’s Dictionary*, <http://www.merriam-webster.com/dictionary/cinderella> (accessed Oct. 22, 2013).

- Exhibit I: *Listing for Cinderella Man*, Internet Movie Database,
http://www.imdb.com/title/tt0352248/?ref_=nv_sr_1 (accessed Oct. 22, 2013).
- Exhibit J: “Fairy Tale High Cinderella Fashion Doll” by SK Victory LLC, Amazon.com,
http://www.amazon.com/Fairy-Tale-High-Cinderella-Fashion/dp/B00D5SDLCS/ref=sr_1_1?s=toys-and-games&ie=UTF8&qid=1381953369&sr=1-1&keywords=cinderella+-disney
(accessed Oct. 17, 2013).
- Exhibit K: “Madame Alexander Dolls 8” Storyland Collection-Cinderella” by Madame Alexander, Amazon.com, http://www.amazon.com/...-Alexander-Dolls-Storyland-Collection/dp/B000O94RS8/ref=sr_1_3?s=toys-and-games&ie=UTF8&qid=1381953369&sr=1-3&keywords=cinderella+-disney
(accessed Oct. 17, 2013).
- Exhibit L: “North American Bear Company Dolly Pockets Cinderella Doll” by North American Bear, Amazon.com, http://www.amazon.com/...merican-Bear-Company-Cinderella/dp/B00EAMHHTG/ref=sr_1_7?s=toys-and-games&ie=UTF8&qid=1381953369&sr=1-7&keywords=cinderella+-disney
(accessed Oct. 17, 2013).
- Exhibit M: “Musical Doll, Cinderella” by Green Tree, Amazon.com,
http://www.amazon.com/...nTree-982-17-Musical-Doll-Cinderella/dp/B0017L8XJQ/ref=sr_1_6?s=toys-and-games&ie=UTF8&qid=1381953369&sr=1-6&keywords=cinderella+-disney
(accessed Oct. 17, 2013).

- Exhibit N: “Alma’s Designs Cinderella Doll” by Alma’s Designs, Amazon.com,
http://www.amazon.com/...as-Designs-CDR-4-Cinderella-Doll/dp/B00080FIMW/ref=sr_1_13?s=toys-and-games&ie=UTF8&qid=1381953369&sr=1-13&keywords=cinderella+-disney
(accessed Oct. 17, 2013).
- Exhibit O: “Shrek Kung Fu Princess Cinderella” by MGA, Amazon.com,
http://www.amazon.com/Shrek-Kung-Fu-Princess-Cinderella/dp/B000MLUDZ4/ref=sr_1_35?s=toys-and-games&ie=UTF8&qid=1381953754&sr=1-35&keywords=cinderella+-disney
(accessed Oct. 17, 2013).
- Exhibit P: “Barbie As Cinderella Collector Edition: The Fairy Tale Beauty Who Lost Her Slipper Doll (1996)” by Mattel, Amazon.com, http://www.amazon.com/...ie-As-Cinderella-Collector-Edition/dp/B001QJSDQW/ref=sr_1_26?s=toys-and-games&ie=UTF8&qid=1381953664&sr=1-26&keywords=cinderella+-disney
(accessed Oct. 17, 2013).
- Exhibit Q: “Penny Brite Doll Cinderella” by Penny Brite, Amazon.com,
http://www.amazon.com/...y-Brite-110209009-Doll-Cinderella/dp/B003AQBR12/ref=sr_1_28?s=toys-and-games&ie=UTF8&qid=1381953692&sr=1-28&keywords=cinderella+-disney
(accessed Oct. 17, 2013)
- Exhibit R: “Play Town: Cinderella & Prince 2-Pack” by Learning Curve,
Amazon.com, http://www.amazon.com/Play-Town-Cinderella-Prince-2-Pack/dp/B000SQLZMI/ref=sr_1_2?s=toys-and-

games&ie=UTF8&qid=1382473227&sr=1-2&keywords=cinderella+-disney
(accessed Oct. 22, 2013).

Exhibit S: “Storytime Cinderella FP Boxed Set” by Storytime, Amazon.com,
http://www.amazon.com/Storytime-Cinderella-FP-Boxed-Set/dp/B0006N52JK/ref=sr_1_1?s=toys-and-games&ie=UTF8&qid=1382473306&sr=1-1&keywords=cinderella+-disney
(accessed Oct. 22, 2013).


ARGUMENT

The Examining Attorney has refused registration of the proposed mark pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that the mark is likely to be confused with the mark in Reg. No. 3,057,988. For the following reasons, Applicant respectfully disagrees with the Examining Attorney’s finding and requests that the Board reverse the statutory refusal and allow publication of the Application.

I. INTRODUCTION

This case concerns the scope of trademark protection that should be afforded a registrant’s use of a public domain fairytale character name in a trademark registration, when the use of the character name in the registered mark relates to just one of countless portrayals of the character in the trademark sector and otherwise. Applicant applied to register the mark ZOMBIE CINDERELLA under Trademark Act Section 1(b), and was denied registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a supposed likelihood of confusion with the WALT DISNEY’S CINDERELLA & Design mark (the “cited mark”) in Registration No. 3,057,988. The marks at issue are depicted in Table 1 below.

Table 1. Relevant Marks

Application Serial No. 85/706,113	Cited Registration No. 3,057,988
ZOMBIE CINDERELLA	 The image shows the Disney Cinderella logo, which includes the word "Disney" in its signature script and "Cinderella" in a stylized font, next to a line drawing of Cinderella in her iconic dress.
<u>Class 28:</u> dolls	<u>Class 28:</u> toys, namely plush toys, action figures, dolls, soft sculpture toys, stuffed toys ²

Apart from the shared weak public domain character term “CINDERELLA,” Applicant’s mark and the cited mark have no discernible similarities. Applicant’s mark juxtaposes the grotesqueness of a monster commonly portrayed in horror films with the beauty and innocence of a classic fairytale princess, giving it a unique and incongruous meaning and overall commercial impression. These striking differences, especially taking into account the weakness of the shared term “CINDERELLA,” weigh heavily against a likelihood of confusion.

If the Examining Attorney’s refusal is upheld in spite of these stark differences, it would be tantamount to holding that the USPTO will not grant federal trademark protection to any mark that brings to mind any fairytale character featured in a trademark registration. The end result is that reasonable uses of such a public domain character would be denied the benefits and rights of trademark protection. Presumably then, only Registrant or one of its licensees may manufacture goods bearing the names and likenesses of these characters with the benefits and rights of trademark protection, regardless of whether the mark’s suggestion of those characters resembles its portrayals. This would rob the public of a valued and treasured public domain asset.

² The cited Disney mark is also registered for use in connection with other goods not stated here, but those goods are not relevant to this proceeding.

Consequently, Applicant respectfully requests that the Board reverse the likelihood of confusion refusal and allow Applicant's mark to proceed to publication.

II. APPLICANT'S "ZOMBIE CINDERELLA" MARK DIFFERS SIGNIFICANTLY FROM THE CITED "WALT DISNEY'S CINDERELLA" & DESIGN MARK.

Notwithstanding the public policy reasons for finding no likelihood of confusion in this case, the marks at issue are quite different.

Likelihood of confusion between two marks at the USPTO is determined by a review of all of the relevant factors under the *du Pont* test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A.1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks, and the relatedness of the goods or services, there is no mechanical test for likelihood of confusion. *See* TMEP § 1207.01; *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563; *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 U.S.P.Q.2d 1201, 1204 (Fed. Cir. 2003). Each of the twelve *du Pont* factors can be considered in weighing likelihood of confusion, if raised, and any one may be dispositive. *See* TMEP § 1207.01.

A. The Marks Differ in Sound and Appearance.

Applicant's ZOMBIE CINDERELLA mark and the cited WALT DISNEY'S CINDERELLA & Design mark differ significantly in sound and appearance. The cited mark



includes stylized wording, a distinctive design, and the house mark WALT DISNEY'S, while Applicant's ZOMBIE CINDERELLA mark comprises only standard characters and features the unshared term "ZOMBIE." The result is that the cited mark includes almost twice as many letters and twice as many words as Applicant's. Additionally, the marks

sound nothing alike because they begin with different sounds (“zom” versus “walt”) and contain different numbers of syllables (6 versus 7).

Although the marks both contain the term “CINDERELLA,” marks are not *per se* likely to be confused merely because they share a common term. *See Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1108, 174 U.S.P.Q. 392, 393 (C.C.P.A. 1972); *In re Hearst Corporation*, 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992). It is well settled that in some circumstances, it is appropriate to recognize that one component of a particular mark may, for some reason, have more significance than other components in determining the commercial impression which is generated by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985). Although the determination of whether or not confusion is likely must be based on a comparison of the marks in their entireties, the dominance of such a significant element must be taken into account in resolving this issue. *Ceccato v. Manifattura Lane Gaetano Morzotto Figli S.p.A.*, 32 U.S.P.Q. 1192 (T.T.A.B. 1994).

Here, the unshared term “ZOMBIE” is dominant in Applicant’s mark because it appears first. Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005). Further, as discussed below, the shared term “CINDERELLA” is weak and diluted, and thus entitled to only a narrow scope of protection.³

³ Applicant is not attempting to collaterally attack the validity of the cited registration. Rather, Applicant merely asserts that the cited registration is entitled to only a narrow scope of protection due to the highly suggestive nature of the shared term “CINDERELLA.”

B. The Marks Have Different Meanings, Connotations, and Overall Commercial Impressions.

Applicant's mark and the cited mark differ significantly in meaning, connotation and overall commercial impression. The cited mark refers to Registrant's 1950 animated film and characters based on a popular public domain fairytale. *See* OAR, Exhibit A. Consumers will further distinguish the cited WALT DISNEY'S CINDERELLA & Design mark as Registrant's because of the house mark at the beginning ("WALT DISNEY'S"), as well as the design



. Thus, the mark's overall commercial impression conjures a classic and innocent portrayal of the public domain fairytale character Cinderella.

On the other hand, Applicant's ZOMBIE CINDERELLA mark is suggestive of a will-less and speechless character capable only of automatic movement who has died and been supernaturally reanimated. *See* OAR, Exhibits B-C. Thus, the dominant first term "ZOMBIE" distances Applicant's mark in meaning from Registrant's portrayal of the character. The first word in a mark plays a dominant role in influencing the commercial impression that the mark engenders. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988); *see also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992).

As a result of the differences in meaning, as well as the differences in appearance and sound, Applicant's and Registrant's respective marks create different overall commercial impressions. In stark contrast to the classic meaning of the public domain "CINDERELLA" character, Applicant's ZOMBIE CINDERELLA mark juxtaposes the grotesqueness of a zombie

with the whimsy of a fairytale princess. This odd combination of horror and fantasy creates a cognitive dissonance in the minds of consumers and results in a feeling of disequilibrium.

C. The Shared Term “CINDERELLA” is Weak and Diluted.

The shared term “CINDERELLA” is very highly suggestive and commercially weak and diluted, and thus entitled to only a narrow scope of protection. Marks containing common elements are not likely to be confused if “the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP § 1207.01(b)(iii); *see, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 U.S.P.Q.2d 1350 (Fed. Cir. 2004). Widespread third-party use of a term in PTO registrations may be offered as evidence of a term’s weakness and dilution with respect to a particular field and weighs in favor of narrowing the scope of its protection against subsequent applications. *Pizza Inn, Inc. v. Russo*, 221 U.S.P.Q. 281, 283 (T.T.A.B. 1983); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1722*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005).

i. The Term “CINDERELLA” is Conceptually Weak and Very Highly Suggestive.

The term shared between the marks, “CINDERELLA,” has little or no source-identifying significance because it is highly suggestive of the well-known fairytale character whose likeness is featured in the design mark and goods for the cited registration. The fairytale character Cinderella is part of a famous public domain fairytale first published by Charles Perrault in *Histoires ou Contes du Temps Passé* in 1697. *See* OAR, Exhibit B. As portrayed in the fairytale “Cinderella,” the character is “a girl of unparalleled goodness and sweet temper,” forced by her stepmother and stepsisters to perform the most unpleasant household chores, who is later swept off her feet by a prince who locates her after finding her misplaced glass slipper. *See* RFR,

Exhibit F. Because the fairytale is a well-known classic, consumers encountering the term “CINDERELLA” in the cited registration will immediately expect the cited goods to feature the character Cinderella.

The evidence supporting the proposition that the term “CINDERELLA” as used in the cited registration refers to the well-known fairytale character Cinderella is overwhelming. The Encyclopedia of American Folklore contains an entry for Cinderella that defines it as perhaps the “most widely known of all fairy tales.” See RFR, Exhibit G. Merriam-Webster’s Dictionary shows that the term CINDERELLA means “one resembling the fairy-tale Cinderella as” (1) “one suffering underserved neglect” and (2) “one suddenly lifted from obscurity to honor or significance.” See RFR, Exhibit H. Other works have used the term Cinderella as suggestive of the fairytale character, such as Ron Howard’s *Cinderella Man* film about boxer James Braddock’s rise from obscurity to boxing champion. See RFR, Exhibit I.

Thus, upon encountering the cited mark, consumers will immediately know that the cited goods feature a depiction of the Cinderella character as she was originally conceived by Charles Perrault. As a result of the term’s widespread public domain use in connection with a princess, “CINDERELLA” is conceptually weak and entitled to only a narrow scope of protection when used in connection with goods that depict a version of the public domain character Cinderella.

ii. The Term “CINDERELLA” is Commercially Weak and Diluted.

The shared term “CINDERELLA” is also commercially weak and diluted. Third-party use of a term in the marketplace may be offered as evidence of a term’s weakness and dilution with respect to a particular field and weighs in favor of narrowing the scope of its protection against subsequent applications. See *Pizza Inn, Inc. v. Russo*, 221 U.S.P.Q. 281, 283 (T.T.A.B.

1983); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1722*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005).

Applicant has already entered into the record nine third-party uses of “CINDERELLA” in connection with dolls and related toys goods. *See* RFR, Exhibits K-S. These third-party uses of “CINDERELLA” conclusively demonstrate that the term “CINDERELLA” is commercially weak and diluted for use in connection with dolls and related toys goods. Applicant has also submitted more than a dozen third-party registrations including the term “CINDERELLA” for use in connection with various goods. *See* OAR, Exhibit D. As a result of these third-party uses and registrations, the cited registration is commercially weak and diluted, and entitled to only a very narrow scope of protection.

Because the term “CINDERELLA” is weak and diluted, more weight must be accorded to any unshared elements of the marks. This includes the differences in appearance, sound, meaning, connotation, and overall commercial impression discussed *supra* in Sections II.A-B, as well as Applicant’s inclusion of the unshared term “ZOMBIE.” *See In re Hunke & Jochheim*, 185 U.S.P.Q. 188, 189 (T.T.A.B. 1975) (“the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or possibly nothing more than a variant of the term, may be sufficient to distinguish them so as to avoid confusion in trade.”).

Therefore, this factor weighs heavily against a finding of likelihood of confusion.

III. UPHOLDING THE EXAMINING ATTORNEY’S REFUSAL WOULD DENY THE PUBLIC A VALUABLE PUBLIC DOMAIN ASSET

As noted *supra* in Section II, the differences between Applicant’s mark and the cited



mark are striking. In light of these differences, affirming the Examining Attorney’s refusal to register Applicant’s ZOMBIE CINDERELLA mark could set a dangerous precedent for denying registration of other marks that incorporate or bring to mind images or impressions of well-known, age-old, public domain fairytale characters.

The fairytale description of the character “Cinderella” leaves much to imagination. Registrant’s portrayal of the character, as illustrated in the design featured in the cited mark, embodies the beauty and innocence the public commonly associates with Disney films. However, Cinderella remains a public domain fairytale character, and while the cited mark may be protected against confusingly similar marks, that protection should not be so broad that it prevents other businesses from obtaining trademark protection for marks which are distinct other than the overlapping character name. An inability to obtain federal trademark protection for marks like ZOMBIE CINDERELLA would preclude Applicant from the benefits of trademark registration, including use of the ® symbol and recordation with Customs and Border Patrol.

It should also be noted that reversing the refusal to register Applicant’s ZOMBIE CINDERELLA mark would not leave Registrant without potential remedies. Following publication, registrant could oppose Applicant’s mark or seek other remedies.

In light of the public policy reasons, along with the differences between the marks, a finding of likelihood of confusion is not suitable.

IV. CONCLUSION

Applicant's ZOMBIE CINDERELLA mark features significant differences from the cited mark with respect to appearance, sound, meaning, connotation, and overall commercial impression. Additionally, the shared term "CINDERELLA" is very weak and diluted with respect to the relevant goods, and is derived from a well-known public domain fairytale by the same name. Thus, there is no likelihood that consumers will be confused as to the source of the goods offered in connection with Applicant's ZOMBIE CINDERELLA mark, and Applicant respectfully requests that the statutory refusal be withdrawn and the Application be permitted to proceed to publication.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the statutory refusal pursuant to Trademark Act §2(d) and allow the Application to proceed to publication.

Dated this 21st day of January, 2014.

Respectfully submitted,



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. 85/706,113

Mark: ZOMBIE CINDERELLA

Applicant: United Trademark Holdings, Inc.

Examining Attorney: David A. Hoffman
Law Office 107